

REMARKS

INTRODUCTION:

Claims 1-22 are pending and under consideration. Reconsideration is respectfully requested.

REJECTION UNDER 35 U.S.C. §103:

At page 2 of the Office Action, claims 1-22 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application No. 2003/0135464 by Mourad et al. in view of U.S. Patent Application No. 2004/0107125 by Guheen et al. The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

REQUEST FOR WITHDRAWAL OF FINALITY

As an initial matter, the Applicants submit that the Examiner did not fully consider and respond to the Amendment filed October 27, 2004. In that amendment, the Applicants characterized Mourad as failing "to suggest that the end user device... distributes the obtained digital content... to another end user device or that the end user device... receives some form of payment for this additional distribution from the end user... to another user." *October 27, 2004 Amendment, Page 7*. The Applicants also characterized Guheen as failing to "suggest one end user distributing received contents to another end user and having the distributor or content provider provide a payment to the one end user." *October 27, 2004 Amendment, Page 8*. The Examiner disagreed with these particular characterizations in the present Office Action. However, the Examiner, both in the response to argument section and the claim rejection section, never points to a specific teaching of these features in the prior art.

Further, claims 1-5 and 12 were amended to further clarify that an aspect of the present invention focuses on distributing contents from a first user to a second user and offering compensation to the first user for that distribution. The Examiner never addressed this amended language in the Office Action. The Applicants submit that at least one of these features is present in each independent claim.

It is believed that the October 27, 2004 Amendment was in proper condition for entry. It is also believed that the October 27, 2004 Amendment presented claims allowable over the art

of record. **Accordingly, the Applicants respectfully request withdrawal of the finality of the present Office Action.**

THE CLAIMS PATENTABLY DISTINGUISH OVER THE PRIOR ART

The Applicants respectfully submit that the rejection fails to establish a prima facie case of obviousness. To establish a prima facie case of obviousness, three basic criteria must be met. MPEP 2142. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *Id.* Second, there must be a reasonable expectation of success. *Id.* Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Id.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *Id.*

Claims 1-5 and 21

Regarding claim 1, the Examiner admits that Mourad fails to teach the digital contents distribution operation as recited. Instead, the Examiner cites Guheen for this feature. The Applicants respectfully disagree. Specifically, claim 1 recites:

after the first user makes the payment to the server, distributing the downloaded digital contents from the first user to a second user.

The Applicants' representative could find no mention in Guheen regarding distributing contents from a first user to a second user after payment by a first user. Rather, Guheen is directed to identifying businesses alliances among a plurality of business entities in components in a network framework.

Guheen is also cited for teaching the operation of offering a predetermined compensation as recited (as the Examiner also admits that this feature is not taught by Mourad).

The Applicants respectfully disagree. Specifically, claims 1 recites:

after the server is accessed and payment for the distributed digital contents is made by the second user, offering a predetermined compensation via the server to the first user who received the downloaded digital contents.

The Applicants' representative was unable to find any mention in Guheen regarding offering a compensation via a server to a first user who received contents and distributed those contents to

a second user.

The Applicants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness, at least because the combination of Mourad and Guheen fails to teach or suggest all of the features recited in claim 1. Accordingly, claim 1 is deemed to allowable over the art of record. Therefore, withdrawal of the §103(a) rejection is respectfully requested.

Regarding the rejection of claims 2-5 and 21, these claims depend directly or indirectly from claim 1 and are therefore believed to be allowable for at least the reasons noted above.

Claims 6-9 and 22

Regarding claim 6, it appears that the Examiner cites Mourad for teaching the access request receiving operation as recited. The Applicants respectfully disagree. Claim 6 recites:

receiving at the server an access request from a second client via
a second communication network if the downloaded digital
contents are distributed from the first client to the second client
and are executed on the second client.

Mourad does not mention receiving an access request from a second client via a second communication network if the contents are distributed from the first client to the second client and executed by the second client. Instead, Mourad is directed to digital contents distribution over a web broadcast infrastructure with a plurality of channels. The Applicants respectfully submit that Guheen also fails to mention the access request receiving operation as recited.

Mourad is apparently cited for teaching the compensation offering operation as recited. The Applicants respectfully disagree. Claim 6 recites

offering via the server the first client a predetermined
compensation if the second client makes payment for the
distributed digital contents.

Neither Mourad nor Guheen mention offering a compensation to a first client if a second client makes payment for distributed contents.

The Applicants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness, at least because the combination of Mourad and Guheen fails to teach or suggest all of the features recited in claim 6. Accordingly, claim 6 is deemed to allowable over the art of record. Therefore, withdrawal of the §103(a) rejection is respectfully requested.

Regarding the rejection of claims 7-9 and 22, these claims depend directly or indirectly from claim 6 and are therefore believed to be allowable for at least the reasons noted above.

Claims 10 and 11

Regarding claim 10, the Examiner appears to cite Mourad for teaching the second user computer as recited. The Applicants respectfully disagree. Claim 10 recites:

a second user computer that receives a copy of the digital contents of the first user computer, is connected to said server computer via a second communication network, and is automatically connected to said server computer if the copy of the digital contents distributed by said first user computer are executed by said second user computer.

Mourad fails to mention a second user computer that receives a copy of the digital contents of a first user computer. Mourad fails to mention a second user computer being connected to a server via a second communication network. Finally, Mourad fails to mention a second user computer that is automatically connected to a server computer if the copy of the digital contents from the first user computer are executed by said second user computer. The Applicants respectfully submit that Guheen also fails to mention the second user computer as recited.

The Examiner also appears to cite Mourad for teaching the operation of offering a predetermined compensation as recited. The Applicants respectfully disagree. Claim 10 recites:

if said second user computer accesses said server to make payment for the copy of the digital contents, a predetermined compensation is offered to a first user of said first user computer who has distributed the copy of the digital contents received by said second user computer.

Neither Mourad nor Guheen mention offering a compensation to a first user if a second user accesses a server to make payment for a copy of digital contents distributed by the first user.

The Applicants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness, at least because the combination of Mourad and Guheen fails to teach or suggest all of the features recited in claim 10. Accordingly, claim 10 is deemed to allowable over the art of record. Therefore, withdrawal of the §103(a) rejection is respectfully requested.

Regarding the rejection of claim 11, this claim depends directly from claim 10 and is therefore believed to be allowable for at least the reasons noted above.

Claims 12 and 13

Regarding claim 12, the Examiner cites Mourad for teaching the indication receiving operation as recited. The Applicants respectfully disagree. Claim 12 recites:

receiving at the server an indication from a receiving client through a communication network that the receiving client received a copy of digital contents from a distributing client, the distributing client having previously offered compensation for the digital contents using the server, with the indication including an identification of the distributing client and that the receiving client is compliant with a license for the digital contents.

Mourad does not mention receiving an indication that a receiving client received a copy of digital contents from a distributing client. Mourad does not mention an indication including an identification of the distributing client and that the receiving client is compliant with a license for the digital contents. The Applicants respectfully submit that Guheen fails to make up for this deficiency.

The Examiner cites Mourad for teaching the operation of offering compensation as recited. The Applicants respectfully disagree. Claim 12 recites:

offering compensation using the server to the distributing client after said receiving at the server the indication from the receiving client.

Mourad does not mention offering compensation to a distributing client after receiving an indication from a receiving client. The Applicants respectfully submit that Guheen fails to make up for this deficiency.

The Applicants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness, at least because the combination of Mourad and Guheen fails to teach or suggest all of the features recited in claim 12. Accordingly, claim 12 is deemed to allowable over the art of record. Therefore, withdrawal of the §103(a) rejection is respectfully requested.

Regarding the rejection of claim 13, this claim depends directly from claim 12 and is therefore believed to be allowable for at least the reasons noted above.

Claims 14-18

Regarding claim 14, the Examiner cites Mourad for teaching the contents receiving operation as recited. The Applicants respectfully disagree. Claim 14 recites:

receiving by a second client a copy of the verified digital contents of the first client.

Mourad does not mention a second client receiving a copy of verified digital contents of a first

client. The Applicants respectfully submit that Guheen fails to makeup for this deficiency.

The Examiner admits Mourad does not teach or suggest the verifying operation as recited. Instead, the Examiner cites Guheen. The Applicants respectfully disagree. Claim 14 recites:

verifying at the server that the second client is compliant with the license for the digital contents through the first or a second communications network prior to allowing the second client to access the copy of the verified digital contents of the first client.

Guheen does not teach a second client being able to access a copy of verified digital contents of a first client.

The Examiner cites Mourad for the operation of offering compensation as recited. The Applicants respectfully disagree. Claim 14 recites:

offering compensation to the first client if the second client is verified to be compliant with the license.

Mourad fails to teach offering a compensation to a first client if a second client is verified to be compliant with a license. The Applicants respectfully submit that Guheen fails to makeup for this deficiency.

Accordingly, the Applicants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness, at least because the combination of Mourad and Guheen fails to teach or suggest all of the features recited in claim 14. Accordingly, claim 14 is deemed to allowable over the art of record. Therefore, withdrawal of the §103(a) rejection is respectfully requested.

Regarding the rejection of claims 15-18, these claims depend directly or indirectly from claim 14 and are therefore believed to be allowable for at least the reasons noted above.

Claims 19 and 20

Regarding claim 19, the Examiner cites Mourad for teaching the server as recited. The Applicants respectfully disagree. Claim 19 recites a server that:

offers compensation to said first client if said second client is verified to be compliant with the license.

Mourad does not mention offering compensation to a first client if a second client is verified to be compliant with a license. The Applicants respectfully submit that Guheen fails to make up for this deficiency.

Accordingly, the Applicants respectfully submit that the Examiner has failed to establish a

prima facie case of obviousness, at least because the combination of Mourad and Guheen fails to teach or suggest all of the features recited in claim 19. Accordingly, claim 19 is deemed to allowable over the art of record. Therefore, withdrawal of the §103(a) rejection is respectfully requested.

Regarding the rejection of claim 20, that claim depends directly from claim 19 and is therefore believed to be allowable for at least the reasons noted above.

CONCLUSION:

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

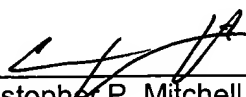
If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: JUNE 7, 2005

By: 
Christopher P. Mitchell
Registration No. 54,946

1201 New York Avenue, NW, Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501